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EXAMINER
VANDERHORST, MARIA VICTORIA

ART UNIT	PAPER NUMBER
3688	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/501,832	MIEDEMA ET AL.
	Examiner	Art Unit	
	M. VICTORIA VANDERHORST	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 June 2008</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

This communication is in response to the amendment filed on 06/30/2008 for the

application No. 10/501,832. Claims 1-10 have been amended. Claims 1-10 are

currently pending and have been examined. Claims 1-10 have been rejected

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-3, 5 and 8-10 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Patent 7,165,071 <u>Fanning</u> et al. in view of US Patent 6,724,914

<u>Brundage</u> et al.

        As to claim 1, Fanning discloses a system of distributing a multimedia object

(**Abstract**) comprising the acts of:

        downloading by a client device the multimedia object from a distributing wherein

the client device is connected to a peer-to-peer file sharing network (**Fanning's system**

is connected in a peer-to-peer file sharing network. He teaches that in his system

the protocol used is Transmission Control Protocol (TCP). It is one of the

standard protocols to transfer data between a pair of computers, peer-to-peer

connection, Col. 3:49-57, Col 4:65-67. Further, Fanning teaches that the downloading act of the data object by the client device is done on-line in real time from a "provider server", "…the requesting server is configured to select a source server from among the server identifiers provided by the search engine, and to download the requested data file from the select source server. A server notifies the search engine when the download is complete…", Abstract, Col. 3:40-49, Figs. 1 and 2.   Further, "…Recipient clients connect to the real-time search engine 10 to find the best provider server that contains the particular data object that the recipient client 16 wishes to download from a provider server. The recipient client preferably uses a recipient browser 18 for communicating with the real-time search engine 10 and for making search requests from the real-time search engine…", Col. 3:40-48).

In addition, in an embodiment of this system the provider server and the recipient client are located in the same executable process (Col. 5:50-54).

Finally, Examiner notes that in the environment of client devices interconnected making requests such as downloading data object from a server, the method of processing the requests is "real time" mode, processing the request in the moment that is required, although it can be done in bath mode);

redistributing by the client device the multimedia object over the peer-to-peer file sharing network (Fanning's system teaches how to distribute objects over a peer-to-peer file sharing network, Claims 1, 3, 4, 6 and 7. Furthermore, Fanning states "…the recipient client simultaneously operates as a provider server to other

recipient clients, making data objects that have been downloaded by the recipient

client available to other recipient clients on the Internet….", Col. 2:44-52, Col.

5:50-62) and

Fanning does not specifically teach rewarding an operator of the client device for the redistributing act.

However, Brundage teaches an incentive or reward embodiment in his system that is a coupon forwarded to the user's email account in response to download an object (showing a watermarked object) (**Col 7:65-67, Col. 8:1-9**).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Brundage's teaching into the system of Fanning.

One would have been motivated to use rewards to incentive the client for redistributing the media object to his/her friends and family in order to increase the profitability of the business.

As to claim 2, Fanning and Brundage disclose a system as in claim 1 above, and Fanning further discloses comprising the act of keeping track of the number of times that the client device redistributes the multimedia object over the peer-to-peer file sharing network (**Claim 5 of Fanning's reference, Col. 6:58-67**),

but Fanning does not disclose wherein the rewarding act is in dependence on said number of times.

However, Brundage teaches in his system a reward for the operator of a client device in dependence on the number of times a multimedia object is redistributed

(**Brundage elaborates on coupons or tickets that can be forwarded to the user's e-mail account in response for some action or act, Col 7:65-67, Col. 8:1-9**).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Brundage's teaching into the system of Fanning. One would have been motivated to utilized the number of requests already queue to a server (client device redistributing media objects) to provide a reward in order to increase the sale or demand of media objects.

As to claim 3, Fanning and Brundage disclose a system as in claim 1 above. But Fanning does not disclose a system in which the reward comprises at least one of a discount on a price normally paid for downloading a multimedia object from the distributing server , a number of points for use in a bonus system, an electronic coupon , a permission to download one or more further multimedia objects from the distributing server , metadata related to the multimedia object , and a ticket for an appearance of a performer of the multimedia object.

However, Brundage teaches in his system the generation of a coupon provided after downloading a multimedia object (**Brundage elaborates on coupons or tickets that can be forwarded to the user's e-mail account in response to some particular action or act, Col 7:65-67, Col. 8:1-9**).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Brundage's teaching into the system of Fanning, in order to provide a coupon or an incentive to a client as a result of having accounting

capability in the server associated to data objects downloads. This enhancement

produces greater satisfaction for the merchant and the client.

As to claim 5, Fanning discloses a system and method for enabling distribution

of a multimedia object (**<u>Abstract</u>**) comprising the acts of:

receiving <u>by a server </u>a request for the multimedia object -from a client device

("… <u>The present invention satisfies these needs by providing a method for</u>

<u>creating a real-time search engine over the Internet that provides a search</u>

<u>response containing data object descriptions and server descriptions 34 of data</u>

<u>objects that are currently available for transfer from a provider server directly to a</u>

<u>recipient client in response to a recipient client search request…", Col. 1:46-54</u>);

forwarding <u>by the server </u>the request to a file sharing network (**<u>in Fanning's</u>**

<u>system the client connects in real time to the provider server that contains the</u>

<u>particular data object that the recipient wishes to download. The communication</u>

<u>between client and server is a browser for making the request, Col. 3:40-48.</u>

<u>Furthermore, "…In one embodiment, each recipient client 16 also connects to a</u>

<u>search engine gateway. In this embodiment, each search engine gateway 44</u>

<u>connects in turn to a search engine 40. All search requests from recipient clients</u>

<u>are transmitted to the search engine gateway, and the search engine gateway</u>

<u>then transmits the search requests to the connected search engine. The search</u>

<u>engine executes the search request, and transmits the search response 38 back</u>

to the search engine gateway, which in turn transmits the search response back

to the originating Recipient client...", Col. 6:48-57);

     receiving <u>by the server</u> an indication from a node -in the file sharing network

indicating that the node -is able to distribute the multimedia object to the client device

(**in Fanning's system the real-time search engine selects the provider server**

(node) that is available to satisfy the client request, "**...the real-time search**

engine further comprises the recipient selecting one of the provider servers in the

search response, and then the recipient client downloading the data object from

the selected provider server...", Col. 2:44-52), and

     <u>distributing the multimedia object from the node to the client device</u> (**Fanning**

states "...the recipient client simultaneously operates as a provider server to

other recipient clients, making data objects that have been downloaded by the

recipient client available to other recipient clients on the Internet....", Col. 2:44-52,

Col. 5:50-62).

     <u>Fanning</u> does not specifically teach rewarding an operator of the node for the

redistributing act.

     However, <u>Brundage</u> teaches an incentive or reward embodiment in his system

that is a coupon forwarded to the user's email account in response to download an

object (showing a watermarked object) (**Col 7:65-67, Col. 8:1-9**).

     Therefore, it would have been obvious to one of ordinary skill in the art, at the

time of the invention, to incorporate <u>Brundage</u>'s teaching into the system of <u>Fanning.</u>

One would have been motivated to use rewards to incentive the client for redistributing the media object to his/her friends and family in order to increase the profitability of the business.

As to claim 8, Fanning and <u>Brundage</u> disclose a system as in claim 5 above, and further Fanning discloses wherein the forwarding includes the acts of:

obtaining a fingerprint for the multimedia (<u>**Col. 5:62-65**</u>); and

submitting a query comprising the fingerprint to the node in the file sharing network (<u>**Fanning's system discloses that a request on a search engine takes place through a query to the database that contains the object stored, Col. 5 :66-67, Col 6:1-16**</u>).

As to claim 9, Fanning discloses a system for enabling distribution of a multimedia object the system comprising:

a distributing server arranged for receiving a request for the multimedia object from a client device **("… The present invention satisfies these needs by providing a method for creating a real-time search engine over the Internet that provides a search response containing data object descriptions and server descriptions 34 of data objects that are currently available for transfer from a provider server directly to a recipient client in response to a recipient client search request…", Col. 1:46-54**)   and for forwarding the request to a file sharing network (<u>**in Fanning's system the client connects in real time to the provider server that contains the**</u>

particular data object that the recipient wishes to download. The communication between client and server is a browser for making the request, Col. 3:40-48. Furthermore, "…In one embodiment, each recipient client 16 also connects to a search engine gateway. In this embodiment, each search engine gateway 44 connects in turn to a search engine 40. All search requests from recipient clients are transmitted to the search engine gateway, and the search engine gateway then transmits the search requests to the connected search engine. The search engine executes the search request, and transmits the search response 38 back to the search engine gateway, which in turn transmits the search response back to the originating Recipient client…", Col. 6:48-57), and

an accounting server for receiving an indication from a node in the file sharing network indicating that the node is able to distribute the multimedia object to the client device (**in Fanning's system the distributing server performs the functions of the accounting server, such as counting and tracking the number of times that the client device downloads data objects, Col. 6:58-67, Fig. 1**)

Fanning does not specifically teach rewarding an operator of the node for said distributing.

However, Brundage teaches an incentive or reward embodiment in his system that is a coupon forwarded to the user's email account in response to download an object (showing a watermarked object) (**Col 7:65-67, Col. 8:1-9**).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Brundage's teaching into the system of Fanning.

One would have been motivated to use rewards to incentive the client for redistributing the media object to his/her friends and family in order to increase the profitability of the business.

As to claim 10, Fanning and <u>Brundage</u> disclose a system as in claim 9 above, and further Fanning discloses the system further comprising a tracking module arranged for keeping track of the number of times that the client device redistributes the particular multimedia object over the peer-to-peer file sharing network, and for transmitting said number of times to the accounting server (**<u>Fanning's system has an embodiment in which the client server and the recipient client are the same, Col. 5:50-65. Additionally, Fanning states "...the recipient client simultaneously operates as a provider server to other recipient clients, making data objects that have been downloaded by the recipient client available to other recipient clients on the Internet....", Col. 2:44-52, Col. 5:50-62. Further in another embodiment , the search engine of his system (accounting server) keeps track of the number of times an object is download from a provider server, Col. 6:58-67</u>**).

3.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 7,165,071 Fanning et al. in view of US Patent 6,724,914 Brundage et al as applied to Claim 1 above, and further in view of US Patent 6,681,029 Rhoads.

As to claim 4, Fanning and <u>Brundage</u> disclose a system and a method as in claim 1 above. But Fanning does not specifically disclose a system further comprising

obtaining an identifier for the operator of the client device before the redistribution act
and embedding the identifier in the multimedia object by a watermark before the client
device downloads the multimedia object .

However, Rhoads teaches in his system obtaining an identifier for the operator
of the client device before the downloading act **(Rhoads discloses in his system a
secret key (identifier), associated with an user or client, incorporated in a private
watermark embedded in an object, Col. 70:33-38**) and

embedding the identifier in the multimedia object by a watermark before the
client device the downloading act **(Rhoads's method applies "…to a variety of
different types of signals, including images, audio and video…", Col.1:64-68.
Further, Rhoads teaches, "…FIG. 2 is a general overview, with detailed
description of steps, of the process of embedding an "imperceptible"
identification signal onto another signal…", FIG. 2. Col. 70:33-38, Col. 45:53-60**).

Therefore, it would have been obvious to one of ordinary skill in the art, at the
time of the invention, to incorporate Rhoads's teaching into the system of Fanning, in
order to provide a watermark protection to multimedia objects. This enhancement
produces greater satisfaction for the merchant, encouraging business development.

4.   Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over
US Patent 7,165,071 Fanning et al. in view of US Patent 6,724,914 Brundage et al as
applied to Claim 5 above, and further in view of US Patent 5,649,013 Stuckey at al.

As to claim 6, <u>Fanning</u> and <u>Brundage</u> disclose a system for distributing a multimedia object as in claim 5 above, but <u>Fanning</u> does not disclose a system further comprising the act of authorizing the request before forwarding the request to the file sharing network.

However, <u>Stuckey</u> teaches a system comprising the act of authorizing the request before forwarding the request to the file sharing network (**<u>Stuckey's system requests subscription, it has a registration process, Col. 2:63-67, Col. 3:1-10</u>**).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate <u>Stuckey</u>'s teaching into the system of <u>Fanning.</u> One would have been motivated to provide protection to the downloading process in order to assure the client have met all the payment requirements before sharing files.

As to claim 7, <u>Fanning</u>, <u>Brundage</u> and <u>Stuckey</u> disclose a system for distributing a multimedia object as in claim 6 above, but <u>Fanning</u> does not disclose a system wherein the authorizing act comprises obtaining payment from an operator of the client device.

However, <u>Stuckey</u> teaches a system that authorizes and obtains payment from an operator of the client device **<u>(Col. 2:63-67, Col. 3:1-10</u>**).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate <u>Stuckey</u>'s teaching into the system of <u>Fanning.</u> One would have been motivated to charge a fee or royalty in order to perform a profitable business activity.

Response to Arguments

5.   The rejection of the claims 1-10 under 35 USC 112 has been withdrawn because the applicant has amended the claims.

a. Applicant's arguments filed 06/30/08 regarding to the rejection of claims 1-10 under 35 USC 103(a) have been fully considered but they are not persuasive.

b. Applicant argues that Fanning does not disclose or suggest redistributing multimedia object by a client device that had downloaded the multimedia object from a distributing server. The examiner disagrees with the Applicant because first of all, Fanning's system states "...the recipient client simultaneously operates as a provider server to other recipient clients, making data objects that have been downloaded by the recipient client available to other recipient clients on the Internet....", Col. 2:44-52. Secondly, Fanning states in an embodiment of this system that the provider server and the recipient client are located in the same executable process, Col. 5:50-62. Finally, Fanning discloses how to distribute objects over a peer-to-peer file sharing network, claims 1, 3, 4, 6 and 7.

c. Applicant argue that Fanning still does not disclose or suggest rewarding an operator of the client device for the redistributing. The examiner disagrees with the Applicant because first of all, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Secondly, Brundage teaches an incentive or reward embodiment in his system that is a coupon forwarded to the user's email account in response to download an object (showing a watermarked object) (**Col 7:65-67, Col. 8:1-9**).

Thirdly, Fanning further discloses comprising the act of keeping track of the number of times that the client device redistributes the multimedia object over the peer-to-peer file sharing network (Claim 5 of Fanning's reference, Col. 6:58-67),

Finally, Rhoads discloses embedding the identifier in the multimedia object by a watermark before the client device the downloading act (Rhoads's method applies "…to a variety of different types of signals, including images, audio and video…", Col.1:64-68. Further, Rhoads teaches, "…FIG. 2 is a general overview, with detailed description of steps, of the process of embedding an "imperceptible" identification signal onto another signal…", FIG. 2. Col. 70:33-38, Col. 45:53-60).

d. Applicant argues that Brundage merely discloses that in response to showing a watermarked CD or music promotion poster, a music file is transferred to the user's personal library on the Internet for access and download at the user's convenience. Such a music transfer is not a reward for anything, but merely a promotion. The examiner disagrees with the Applicant because first of all , per definition of reward it is something given or received in returns or recompense for service, merit, hardship. An electronic coupon is a reward. Secondly, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, Brundage elaborates on coupons

or tickets that can be forwarded to the user's e-mail account in response for some

action or act, Col 7:65-67, Col. 8:1-9.

Conclusion

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to M. VICTORIA VANDERHORST whose telephone

number is (571)270-3604. The examiner can normally be reached on regular.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Myhre can be reached on 571 272 6722. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. V./
Examiner, Art Unit 3688

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688